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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jingrui Wu *et al.*

Serial No. 10/678,588

Filed: October 2, 2003

Title: **Yield-Improved Transgenic Plants**

Art Unit: 1638

Examiner: Vinod Kumar

Docket No. 38-21(52578)C

**Renewed Petition to Amend Priority Under 37 C.F.R. § 1.78(a)(3)**

Commissioner for Patents

Fax: 571-273-8300

Attn: Office of Petitions

Sir:

Responsive to the Decision on Petition under 37 CFR 1.78(a)(3), mailed October 20, 2006, applicant submits

- (a) this renewed petition to amend priority claims in the above-captioned U.S. application under 37 C.F.R. § 1.78(a)(3);
- (b) a substitute amendment
- (c) a copy of the above-referenced Decision.

Applicant understands from a reading of that Decision that the prior petition was denied because the earlier-proposed amendment to the specification in the "Reference to Related Applications" section would have improperly incorporated by reference the prior filed application. The decision further instructed applicant that before the petition can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required.

**Certificate of Facsimile Transmission** - I certify that this communication ( 7 pages) is being facsimile transmitted to the USPTO at fax number 571-273-8300 on February 28, 2007.

  
Thomas E. Kelley - Reg. No. 29,938**BEST AVAILABLE COPY**

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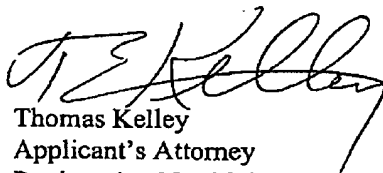
To comply with the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) of the prior filed application, applicant submits herewith a substitute amendment to the specification in which reference to the prior filed application does not include an incorporation by reference.

Fee Authorization: Applicant understands the surcharge set forth in § 1.17(t) has been paid. If this is incorrect, the Commissioner has been authorized to charge to Deposit Account No. 134125 of Monsanto Company for that fee.

Applicant hereby renews the petition to add a claim of priority to U.S. application Serial No. 09/865,439 under 37 C.F.R. § 1.78(a)(3) and requests consideration of this petition in view of the substitute amendment. Applicant again asserts that the entire delay between the date for making a priority claim under 37 C.F.R. § 1.78(a)(2)(ii) and the date such priority claim was made was unintentional, and respectfully request that this above-captioned application be amended to reflect the priority for the invention now claimed.

Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,

  
Thomas Kelley  
Applicant's Attorney  
Registration No. 29,938  
Phone: 860- 572-5274

Date: February 28, 2007



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ATTENTION: GAIL P. WUELLNER, IP PARALEGAL, (E2NA)  
ST. LOUIS, MO 63167

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OCT 20 2006

OFFICE OF PETITIONS

In re Application of :  
Jingrui Wu, et. al. :  
Application No. 10/678,588 : DECISION ON PETITION  
Filed: October 2, 2003 : UNDER 37 CFR 1.78(a)(3)  
Attorney Docket No. 38-21(52578)C :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed by facsimile transmission on April 28, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed with the petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above.

The reference to add the prior-filed application on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing

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application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required.

Further correspondence with respect to this matter should be addressed as follows:

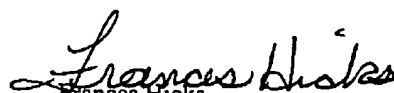
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Alexandria, VA 22314

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In the meantime, this application file is being referred to Technology Center Art Unit 1638, for consideration of the Request under 37 CFR 1.48 filed on April 28, 2006.

Any questions concerning this matter may be directed to Andrea Smith at (571) 272-3226:

  
Frances Hicks  
Petitions Examiner  
Office of Petitions